

### **REMARKS/ARGUMENTS**

This Application is currently under final rejections. After a telephone communication with Examiner Kim which took place on August 28, 2003, Applicants have decided to file an RCE to continue the prosecution of this application. The Examiner's constructive advice is well taken and Applicants thank the Examiner for the suggestions.

In the final office action dated June 4, 2003, claims 2, 18, 20-26, and 28-32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-2 and 27-29 are rejected under 35 U.S.C. §102(b) as being anticipated by Guengerich et al, U.S. Patent No. 5,886,157 (hereinafter as "the '157 patent"). Claims 1-2 and 17-29 are rejected under 35 U.S.C. §102(b) as being anticipated by Shade et al., WO00/62769 (hereinafter as "the WO'769 patent").

Applicants also acknowledge safe receipt of the "Notice of References Cited" (form PTO-892) and the attached references.

In response to these rejections, Applicants have cancelled claims 1-2 and 17-32 (claims 3-9 have been previously canceled and claims 10-16 have been previously withdrawn). New claims 33-47, which are directed to "methods of use," are added to replace the compound claims in the previous amendments, in accordance with the Examiner's advice. In addition, Applicants have amended the specification to change the title from "dermal Cytochrome P450 1A inhibitors and Enhancers" to -- Cytochrome P450 1A inhibitors and enhancers --, and to correct "CYP1A" to --CYP1A1--, due to inadvertent mistakes. No new matter has been introduced.

Applicants respectfully submit that the amendment have overcome the rejections for reasons set forth below:

#### ***Claim rejections under 35 U.S.C. §112, second paragraph***

Claims 28-32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for lacking antecedent basis. Claims 18, and 20-26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to further limiting the scope of claims.

In response to these rejections, Applicants have cancelled the claims, so that the issues in the rejections are moot.

***Claim rejections under 35 U.S.C. §102(b)***

Claims 1-2 and 27-29 are rejected under 35 U.S.C. §102(b) as being anticipated by the '157 patent. Claims 1-2 and 17-29 are rejected under 35 U.S.C. §102(b) as being anticipated by the WO'769 patent.

In response to these rejections, Applicants have cancelled claims 1-2 and 17-32, and replaced them with new claims 33-47, which are "method of use" claims..

Because new claims 33-47 do not claim  $\alpha$ -naphthoflavone as a cytochrome P450 1A (CY1A) inhibitor, the new claims are not anticipated by the '157 patent.

With regard to Shade et al. WO00/62769 (hereinafter WO'769), the Examiner alleges that "WO'769 teaches a compound (i.e.,  $\beta$ -naphthoflavone) and a composition containing  $\beta$ -naphthoflavone. WO'769 further teaches a topical composition containing  $\beta$ -naphthoflavone as an effective active agent.

However, the topical composition referred to by the Examiner is for treatment of glaucoma or ocular hypertension, which is totally different from Applicants' claims of prolonging the therapeutic effect of a drug on skin or in the liver or preventing skin cancer. Also, there is no "inherency" for the use of  $\beta$ -naphthoflavone as a CYP1A inhibitor. A new use of an old compound is clearly patentable under 35 U.S.C. § 101. Therefore, the present claimed invention is not anticipated by WO'769.

Applicants therefore respectfully request that the rejections over the '157 patent and WO'769 be withdrawn.

In view of the foregoing, the rejections have been overcome and the claims are in condition for allowance, early notice of which is requested. Should the application not be passed for issuance, the examiner is requested to contact the applicant's attorney to resolve the problem.

Respectfully submitted,

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